UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,015	01/08/2001	Sajid Ahmed	53296-2	7094

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ART UNIT	PAPER NUMBER
2121	7

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _Jan. 8, 2001_ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-23_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-23_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _Aug. 13, 2001_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a)☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)   4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   5)☐ Notice of Informal Patent Application (PTO-152)

3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _6_ .   6)☐ Other: .

DETAILED ACTION

1.   This Office Action is responsive to application 09/757,015, filed January 8, 2001.

2.   Claims 1-23 have been examined.

Drawings

3.   The formal drawings have been reviewed by the United States Patent & Trademark

Office of Draftsperson's Patent Drawings Review.

Specification

4.   The summary of the invention is objected to because it is a repetition of the claims using

the same claim language. It should be a brief summary or general statement of the invention as

set forth in 37 CFR 1.73. The summary may point out the advantages of the invention or how it

solves problems previously existent in the prior art. If possible, the nature and gist of the

invention or the inventive concept should be set forth. Objects of the invention should be treated

briefly and only to the extent that they contribute to an understanding of the invention See

MPEP § 608.01(d). Correction is required.

5.   The specification has not been checked to the extent necessary to determine the presence

of all possible minor errors. Applicant's cooperation is required to correcting any errors of which

applicant may become aware in the specification. Appropriate correction is required.

Claim Rejections - 35 USC § 101

6.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

7.   The invention as disclosed in claims 1-5 is directed to non-statutory subject matter i.e., an

abstract idea. The claims appear to be a method performed on a computer. However, applicant

discloses no specific computer-readable medium. The claims are merely a manipulation of an

abstract idea and therefore are nonstatutory. Furthermore, the limitations as claimed do not

define any structural and functional interrelationships between the computer program and other

claimed elements of a computer which permit the computer program's functionality to be

realized *(see In re Warmerdam, 33 F.3d 1354, 31 USPQ2d 1754(Fed.Cir.1994).*

8.   On this basis, claims 1-5 are rejected under *35 USC § 101*

Claim Rejections - 35 USC § 112

9.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10.   Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with

the enablement requirement. Applicant failed to disclose a practical application for claims 1-5

and therefore, does not disclose in such full, clear, and concise terms methodology enabling one

of ordinary skill in the art to make and use applicant's claimed invention without undue and

unnecessary experimentation.

Claim Rejections - 35 USC § 112

11.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

12.   Claims 4, 10, and 19 contains the trademark/trade name ELICIT™"Algorithm 42".

Where a trademark or trade name is used in a claim as a limitation to identify or describe a

particular material or product, the claim does not comply with the requirements of 35

U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The

claim scope is uncertain since the trademark or trade name cannot be used properly to identify

any particular material or product. A trademark or trade name is used to identify a source of

goods, and not the goods themselves. Thus, a trademark or trade name does not identify or

describe the goods associated with the trademark or trade name. In the present case, the

trademark/trade name is used to identify/describe a core algorithm used to process, one or more

values and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

13.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14.   Claims 1-4 and 6-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Lenz.

Regarding claim 1:

Lenz teaches (a),(b),(c),(d),(e), and (f)

(a) establishing a possibility set comprising a plurality of alternative possibilities, each

having a distinguishing attribute(col.3, lines 21-29, "Qualities...for some number of different");

(b) establishing a query set comprising a query(col.4, lines 9-11); (c) relating the query to each

alternative in the possibility set using a set of primary bias values provided by an expert having

knowledge of the alternatives, wherein each primary bias value is associated with a particular

alternative, and reflects the expert's conception, based on the distinguishing attribute, of the

relative degree of predictive value of the query for the particular alternative relative to other

alternatives in the possibility set (col.3, lines 26-28, lines31-33); (d) obtaining a response to the

query (col.4 lines 15-17); (e) determining, based on the response to the query and the set of

primary bias values, a set of corresponding secondary bias values, wherein each secondary bias

value is associated with a particular alternative, and reflects the expert's conception of the

relative degree of predictive value of the query for the particular alternative relative to other

alternatives in the possibility set(col.4, lines 33-35); and (f) ranking the alternatives in the

possibility set, based on the secondary bias values, to provide a decision comprising the set of

alternatives, ranked according to likelihood (col.4, lines 36-39).

Furthermore, Lenz teaches all of the above limitations implemented on a conventional computer

including a processor, memory, storage device, mouse, keyboard, and display (col.6, lines 13-

18).

Regarding claim 2:

Rejection of claim 1 is incorporated and Lenz teaches further limitation recites wherein

determining the set of secondary bias values involves increasing, decreasing or conserving the

corresponding primary bias values based on the response to the query (col.8. lines 57-65,

"method is to increase…decrease").

Regarding claim 3:

Rejection of claim 1 is incorporated and Lenz teaches further limitation recites wherein the query

set comprises a plurality of queries, and wherein ranking the alternatives in the possibility set

involves summing and averaging of the primary or secondary bias values (col.18, lines 25-29).

Regarding claim 4:

Rejection of claim 1 is incorporated and Lenz teaches further limitation recites wherein

determining a set of corresponding secondary bias values, and ranking the alternatives in the possibility set is achieved by using an ELICIT.TM. "Algorithm 42" core algorithm to process one or more of the primary or secondary bias values (col.5, lines 42-47).

Regarding claim 6:

Lenz teaches (a) configuring, in one or a plurality of electronic data bases stored in the storage device of the computer, a possibility set comprising a plurality of alternative possibilities, a query set comprising a query, and a set of primary bias values provided by an expert having knowledge of the alternatives, wherein each primary bias value is associated with a particular alternative, and reflects the expert's conception of the relative degree of predictive value of the query for the particular alternative relative to other alternatives in the possibility set (see Fig.1, col.6, lines 31-57, "database...possible values"); (b) inputting a user's response to the query into the computer (col.6, lines 63-65); and (c) ranking, using a program stored on the storage device that is operative with the processor to receive and process the user's response, the set of alternative possibilities according to relative likelihood, based at least in part on the set of primary bias values, whereby a decision, comprising the set of ranked alternatives, is provided (see Fig.1, col.7, lines17-42, "executable module...ranked list").

Regarding claim 7:

Rejection of claim 6 is incorporated and Lenz teaches querying the electronic data bases to determine, based on the response to the query and the set of primary bias values, a set of corresponding secondary bias values, wherein each secondary bias value is associated with a particular alternative, and reflects the expert's conception of the relative degree of predictive

value of the query for the particular alternative relative to other alternatives in the possibility set.(

col.8, lines 23-25)

Regarding claim 8:

Rejection of claim 6 is incorporated and Lenz teaches determining the set of secondary bias

values involves increasing, decreasing or conserving the corresponding primary bias values

based on the response to the query (col.8. lines 57-65).

Regarding claim 9:

Rejection of claim 6 is incorporated and Lenz teaches ranking the alternatives in the possibility

set involves summing and averaging of the primary or secondary bias values.

(col.18, lines 25-29).

Regarding claim 10:

Rejection of claim 6 is incorporated and Lenz teaches determining a set of corresponding

secondary bias values, and ranking the alternatives in the possibility set is achieved by using an

ELICIT.TM. "Algorithm 42" core algorithm to process one or more of the primary or secondary

bias values (col.5, lines 42-47).

Regarding claim 11:

Rejection of claim 1 is incorporated and further contain limitation recites in claim 1, therefore

claim 11 is rejected under same rational as claim 1.

Regarding claim 12:

Rejection of claim 1 and 6 are incorporated and further contain limitation recites in claim 1 and

6, therefore claim 12 is rejected under same rational as claim 1 and 6. (See Fig.1)

Claim Rejections - 35 USC § 103

15.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

16.   Claims 5 and 13-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lenz

(USPN 5,784,539), Filed: Nov.26, 1996; Date of Patent: Jul.21, 1998 taken with

Goldenberg (USPG Pub.20020065682), filed May 18, 1999.

Regarding claim 5:

Rejection of claim 1 is incorporated and

Lenz does not teach specifically wherein the possibility set is a set of alternate **medical**

diagnoses, wherein the expert is a **medical expert**, and wherein ranking the alternatives in the

possibility set, based on the secondary bias values, provides a **diagnosis** comprising the set of

alternate **medical diagnoses**, ranked according to likelihood.

However, Goldenberg teaches an **interactive network-based virtual doctor cybernet system**

that provides diagnosis services via a wide-area network. (see Fig.8, page2, paragraph 15, "a

server...over a network).

It would have been obvious to one of ordinary skill in the art at the time the invention was made

to combine Lenz with that of Goldenberg. Specifically, to dispose in the medical domain, an

expert system that would be more efficient and economical by providing medical self-

assessment to the patient at lower cost in less time than it would take to make an appointment
with the doctor.

Regarding claim 13:

Rejection of claim 12 is incorporated and

Lenz does not teach wherein the program is operative with the processor to store user

information in the user database, and update user information when new user information is

received.

Goldenberg teaches wherein the program is operative with the processor to store user

information in the user database, and update user information when new user information is

received (Fig.5, step 515).

It would have been obvious to one of ordinary skill in the art at the time the invention was made

to combine Lenz with that of Goldenberg to maintain accurate and up-to-date information on

users thereby in keeping with the scope and spirit of the invention by providing more current

information more quickly.

Regarding claim 14:

Rejection of claim 12 is incorporated and

Lenz does not teach wherein the program is farther operative with the processor to track user

information.

Goldenberg teaches wherein the program is operative with the processor to track user

information. (Fig.5, step 514)

It would have been obvious to one of ordinary skill in the art at the time the invention was made

to combine Lenz with that of Goldenberg to maintain a database of user information in order

receive, store and transmit patient history thereby making any future interactions more

streamlined. Also, by tracking user information, an analysis can be done to determine how often

that particular user has accessed the medical expert system and what the diagnosis was.

Regarding claim 15:

Rejection of claim 1 is incorporated and

Lenz does not teach the process over a wide-area network.

However, Goldenberg teaches an **interactive network-based virtual doctor cybernet system**

that provides diagnosis services via a wide-area network. (see Fig.8, page2, paragraph 15, "a

server...over a network).

It would have been obvious to one of ordinary skill in the art at the time the invention was made

to combine Lenz with that of Goldenberg . Specifically, to provide up-to-date medical

information directly to the user quickly, thereby making health care less costly and less time-

consuming by making it more accessible to users.

Regarding claim 16:

Rejection of claim 6 and 15 are incorporated and further contain limitation recites in claim 6 and

15, therefore claim 16 is rejected under same rational as claim 6 and 15.

Regarding claim 17:

Rejection of claim 16 is incorporated and further contain limitation recites in claim 16, therefore

claim 17 is rejected under same rational as claim 16.

Regarding claim 18:

Rejection of claim 16 is incorporated and further contain limitation recites in claim 16, therefore

claim 17 is rejected under same rational as claim 16.

Regarding claim 19:

Rejection of claim 16 is incorporated and further contain limitation recites in claim 16, therefore

claim 19 is rejected under same rational as claim 16.

Regarding claim 20:

Rejection of claim 5 and 15 are incorporated and further contain limitation recites in claim 5 and

15, therefore claim 20 is rejected under same rational as claim 5 and 15.

Regarding claim 21:

Lenz does not teach a computer network apparatus with the limitations of **(a)** a server

comprising a processor and a storage device connected to the processor; **(b)** a possibility set

database stored on the storage device, wherein the possibility set database comprises a plurality

of alternative possibilities; **(c)** a query set database stored on the storage device, wherein the

query set database comprises a query; **(d)** a primary bias value data set stored on the storage

device, wherein the primary bias values are provided by an expert having knowledge of the

alternative possibilities, and wherein each primary bias value is associated with a particular

alternative, and reflects the expert's conception of the relative degree of predictive value of the

query for the particular alternative relative to other alternatives in the possibility set; and **(e)** a

program stored on the storage device for controlling the processor, wherein **(i)** the program is

operative with the processor to receive, from a user subsystem, a user's response to a query, **(ii)**

determine, based on the response to the query and the set of primary bias values, a set of

corresponding secondary bias values, wherein each secondary bias value is associated with a

particular alternative, and reflects the expert's conception of the relative degree of predictive

value of the query for the particular alternative relative to other alternatives in the possibility set,

(iii) rank the alternatives in the possibility set, based on the secondary bias values, to provide a

decision comprising the set of alternative possibilities, ranked according to likelihood, and **(iv)**

transmit the decision to the user subsystem.

Goldenberg teaches all the above limitations with respect to a server comprising a processor and

a storage device connected to the processor (see Fig.1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made

to combine Lenz with that of Goldenberg to provide for a computer network apparatus in the

medical domain that would be allowing widespread user access to numerous sources of medical

information at lower cost and in less time than it would take to make an appointment with the

doctor.

Regarding claim 22:

Rejection of claim 13 and 21 are incorporated and further contain limitation recites in claim 13

and 22, therefore claim 22 is rejected under same rational as claim 13 and 21.

Regarding claim 23:

Rejection of claim 14 and 21 are incorporated and further contain limitation recites in claim 14

and 23, therefore claim 23 is rejected under same rational as claim 13 and 21.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure, Anderson et al. USPN 6,394,952, Barry et al. USPN 6,081,786, Hekmatpour USPN

5,870,768, Lawrence et al. USPN 6,272,481, McAndrew et al. USPN 5,517,405, and Sloane
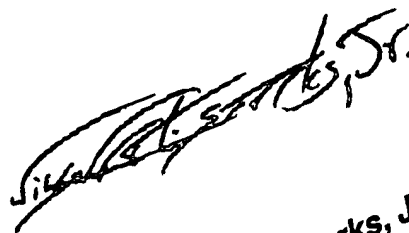USPN 5,911,132.

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Anh Nguyen whose telephone is (703) 305-8649. The examiner
can normally be reached on Monday-Friday from 8:00am to 5:00pm.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Anil Khatri
can be reached at (703) 305-0282. The fax number for the organization where this application
proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for
After Final communications.

Any inquiry of a general nature or relating to the status of this application should be
directed to the Group receptionist whose telephone is (703) 305-3900.

September 15, 2003

AN

Wilbert L. Starks, Jr.
Primary Examiner
Art Unit - 2121